

Remarks

Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of the claims in view of the following comments.

For the Examiner to establish a prima facie case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th ed.).

With respect the rejection fails on all 3 criteria.

For the Patent Office to combine references in an obviousness analysis, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994,999 (Fed. Cir. 1999). While the range of sources for the motivation is broad, the range of available sources does not diminish the requirement for actual evidence. *Id.*

In his rejection, the Examiner states:

“ Bell discloses all the claimed limitations, except a stream switch fabric. However, in the same field of endeavour, Valhalia (5,933,603) discloses an ATM switch 53-fig.2 for switching a number of streams (i.e., streams from stream servers 21-26) to appropriate output interfaces (col.6, lines 24-38 & see fig.2). Therefore, it would have been obvious to an artisan to apply Vahalia's teaching to Bell's system with the motivation being to provide streams (i.e., real time video) to users upon demand.”

First, we dispute that Valhalia and Bell are in the same field of endeavor. Valhalia is directed to a video on demand service. Bell has absolutely nothing to do with this. The word “video” does not even appear in Bell. Bell is directed to an information handling system, such as a

microprocessor (see Summary, Col 2 lines 5-6), for buffer management based on bandwidth and latency constraints. They are directed to different problems, they teach different solutions, they have different field of inventions and they classified by the USPTO in different US and International classes. They are not in the same field of endeavor.

Accordingly, we respectfully submit that there is no motivation or suggestion to combine these references, apart from forbidden hindsight analysis based on the present application.

In order to prevent hindsight analysis, there must be some motivation or suggestion to combine specific prior art in such a way as to arrive to the combination disclosed in the patent at issue. See, e.g., *Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 1343 (Fed. Cir. 2000): *"the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test of obviousness."*, and *Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d at 1371-1372 (Fed. Cir. 2000), *"Combining prior art references without evidence or a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight."*

In any event, the examiner's statement that it would have been obvious to an artisan to apply Vahalia's teaching to Bell's system with the motivation being to provide streams (i.e., real time video) to users upon demand is a mere assertion which is simply not supported by either reference.

Accordingly, it is respectfully submitted that the rejection fails to establish a prima facie case of obviousness, by failing to provide and support an adequate motivation to combine the cited references to support the rejection.

Furthermore, with respect to criteria 3, even if the references can be combined (which is denied), such a combined reference fails to teach all of the limitations of claim 1.

As admitted by the examiner, Bell does not teach an stream switch fabric.

Similarly, Vahalia does not teach, suggest or even mention a stream switch fabric. Indeed, Neither the cited passages, nor Vahalia in general, teach, suggest or mention any type of fabric.

Vahalia teaches a video file server for serving popular movies to viewers.

The examiner alleges that “ Valhalia (5,933,603) discloses an ATM switch 53-fig.2 for switching a number of streams (i.e., streams from stream servers 21-26) to appropriate output interfaces (col.6, lines 24-38 & see fig.2).”

However, nothing in the cited passage or in Figure 2 teaches or suggests that ATM switch is anything other than a conventional ATM switch. Indeed , the very passage cited by the examiner, at lines 26-30 states (emphasis added): “The network 25, for example, has **conventional switching mechanisms**, such as an ATM switch 53 or arrays of cross-bar switches, that permit any one of the clients 54 to communicate with any one of the stream servers 21.”

In short, Valhalia does not teach or suggest the use of any stream switch fabric, let alone a stream switch fabric as claimed.

Accordingly, even if the references can be combined (which is expressly denied), any combination of the references still fails to teach the claimed invention.

Accordingly, withdrawal of the rejections to claims 1-19, 20, and 35-36 in section 2 of the official action is hereby requested.

Regarding the rejection to claims 21-34 in section 3 of the Official Action, or to claim 37 in section 4 of the Official Action, the rejection is traversed as the Amulhem reference shall not preclude patentability, as it is a 102(e) reference to which 35. USC 103(c) applies.

STATEMENT under 103(c)

Applicants hereby state that at the time the claimed invention was made, the subject application and the Amulhem reference were owned by the same person or subject to an obligation of assignment to the same person, namely the assignee Nortel Networks Ltd.

Accordingly the rejection to claims 21-34 in section 3 of the Official Action, or to claim 37 in section 4 of the Official Action should be withdrawn.

Accordingly all of the claims in the present application are allowable, and notice of allowance is hereby requested.

No fee is believed due for this submission. However, Applicant authorizes the Commissioner to debit any required fee from Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP. The Commissioner is further authorized to debit any additional amount required, and to credit any overpayment to the above-noted deposit account.

Respectfully submitted,

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